

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

PCT

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

### FOR FURTHER ACTION

See paragraph 2 below

International application No.  
PCT/US2004/009610

International filing date (day/month/year)  
29.03.2004

Priority date (day/month/year)  
28.03.2003

International Patent Classification (IPC) or both national classification and IPC  
A61B18/14

Applicant  
C.R. BARD, INC.

#### 1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

#### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

#### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**International application No.  
PCT/US2004/009610**Box No. I Basis of the opinion**

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
 This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:  
 a sequence listing  
 table(s) related to the sequence listing
  - b. format of material:  
 in written format  
 in computer readable form
  - c. time of filing/furnishing:  
 contained in the international application as filed.  
 filed together with the international application in computer readable form.  
 furnished subsequently to this Authority for the purposes of search.
3.  In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**Box No. II Priority**

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1.  The following document has not been furnished:

- copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).
- translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2.  This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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**Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

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The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- the entire international application,  
 claims Nos. 19-34

because:

- the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (*specify*):  
 the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 19-34 are so unclear that no meaningful opinion could be formed (*specify*):

**see separate sheet**

- the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.  
 no international search report has been established for the whole application or for said claims Nos.  
 the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form                    has not been furnished

does not comply with the standard

the computer readable form      has not been furnished

does not comply with the standard

- the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.

- See separate sheet for further details

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**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or  
industrial applicability; citations and explanations supporting such statement**

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**1. Statement**

Novelty (N)	Yes:	Claims	2,4,6-18,36
	No:	Claims	1,3,5
Inventive step (IS)	Yes:	Claims	
	No:	Claims	2,4,6-18,36
Industrial applicability (IA)	Yes:	Claims	1-18,35,36
	No:	Claims	

**2. Citations and explanations**

**see separate sheet**

**Re Item III**

**Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The various definitions of the subject-matter given in the plurality of independent claims, each reciting a different combination of limitations expressed at different levels of generalizations and largely repetitive, are such that the claims as a whole are not clear and concise. The requirements of Article 6 PCT, therefore, are not met.

Consequently, the different combinations of features recited in the plurality of independent claims do not allow to correctly identify "the claimed invention" on which an opinion in the sense of Article 33.1 PCT should be based.

Therefore, this presentation of a number of independent claims makes it difficult, if at all possible, to determine the matter for which protection is sought and places an undue burden to others seeking to establish the extent of monopoly requested. For this reason a full substantive preliminary examination cannot be carried out until the claims meet Article 6 PCT.

In the following only the claims 1 and 35 and subclaims are treated.

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

- 1 The following document is referred to in this communication:

D1 : US 6 514 246 B1 (FLEISCHMAN SIDNEY D ET AL) 4 February 2003 (2003-02-04)

**2 INDEPENDENT CLAIM 1**

- 2.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.

Document D1 discloses (the references in parenthesis applying to this document):

*a catheter comprising:*

*a catheter shaft (38) having an insulating material and a diameter; and  
an ablation electrode (34) forming a junction with the shaft, the ablation electrode having an exposed surface;*

*wherein, extending from the junction, the exposed electrode surface has a first diameter portion with a first diameter that is smaller than the shaft diameter, the first diameter portion forming an angle with the insulating material; and*

*wherein the exposed electrode surface has a second diameter portion with a second diameter that is larger than the first diameter of the first diameter portion, the second diameter portion having a largest diameter that is smaller than a length of the second diameter portion (cf. col. 17, I.46 - col.18, I.3; fig. 5,28).*

**3 INDEPENDENT CLAIM 35**

- 3.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 35 is not new in the sense of Article 33(2) PCT for the same reasons as indicated under § 2.

**4 DEPENDENT CLAIMS 2-18,36**

Dependent claims 2-18,36 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step (Article 33(2) and (3) PCT), see the documents and respective passages cited in the search report.